



RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named
Inventor : Kevin I. Bertness

Appln. No.: 10/681,666

Filed : October 8, 2003

For : ELECTRONIC BATTERY TESTER WITH
PROBE LIGHT

Docket No.: C382.12-0169

Group Art Unit: 2838

Examiner:

Edward H. Tso

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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A. Rego

PATENT ATTORNEY

Sir:

Applicant respectfully requests Pre-Appeal Brief Review of the rejection of claims 1-27 under ¶103(a), based on Bertness (US 6,316,914) in view of Applicant's own admitted prior art on page 11 of the Specification, since the rejection is based on an incorrect application of law to fact.

ARGUMENT

Claim 1, which is directed to an electronic battery tester for testing a storage battery, includes "a probe light configured to couple to at least one of the first and second Kelvin connections, the probe light having a longitudinal axis that is oriented generally toward an end, of one of the first and second Kelvin connections, that couples to one of the first and second terminals of the battery."

The Office Action first acknowledges that the cited prior art does not show the above-noted feature of claim 1, but goes on to state that separate lighting equipment and battery testers currently exist. Based on this statement, the Office Action concludes that it would have been obvious to one having ordinary skill in the art to have integrated the light onto the Kelvin connection, since it has been held, in *In re Larson*, that the use of one piece construction instead of two or more pieces would be merely a matter of obvious engineering choice.

Applicant respectfully points out that the above conclusion is incorrect because the holding in *In re Larson* is not applicable if the claimed invention eliminates a need, perceived by the prior art, that arises out of using separate components instead of a unitary structure. As will be discussed in detail further below, claim 1 eliminates a need, perceived by the prior art, for positioning separate lighting equipment while operating a battery tester and therefore the holding in *In re Larson* does not apply to claim 1.

Section 2144.04 of the Manual of Patent Examining Procedure (MPEP) includes, under a sub-section related to making integral, the following:

“In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (. . . ‘the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.’); but see *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine . . . comprising a holding structure, a base structure, and a supporting means which form ‘a single integral and gaplessly continuous piece.’ Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure . . .).” (Emphasis Added.)

As can be seen in the underlined language above, in *Schenck*, attaching multiple pieces by bolting the pieces together was already known. In *Schenck*, the claimed invention simply integrates pieces, which could already be attached, into a continuous piece. Yet, the Court in *Schenck* focused, not on the combining of multiple pieces, but on a need to dampen resonance, perceived by the prior art, that the claimed invention eliminated. Accordingly, the Court in *Schenck* held that *In re Larson* is not applicable if the claimed invention eliminates a need,

perceived by the prior art, which arises out of using separate components instead of a unitary structure. Claim 1, in a manner akin to the invention described in *Schenck*, eliminates a need, perceived by the prior art, for positioning additional lighting equipment while operating a battery tester.

Page 11, lines 18-27 of the Applicant's specification (cited as prior art in the Office Action) include the following:

“In general, when required, separate lighting equipment such as a torch is utilized to illuminate a battery environment during battery testing. However, employing separate lighting equipment during battery testing makes the testing and lighting equipment difficult to properly position and operate in a constrained and poorly lit environment associated with, for example, testing of batteries wherein the battery terminals are recessed in cabinets.” (Emphasis Added.)

Integrating the lighting equipment with at least one Kelvin connection of a battery tester, in accordance with the invention of claim 1, eliminates the above-described need for positioning the lighting equipment. Specifically, “the probe light having a longitudinal axis that is oriented generally toward an end, of one of the first and second Kelvin connections, that couples to one of the first and second terminals of the battery,” as required by claim 1, eliminates any need for properly positioning separate lighting equipment. Thus, claim 1 is allowable based on the above MPEP section.

Independent claim 25 has elements similar to that of independent claim 1. Thus, for the same reasons as independent claim 1, Applicant submits that independent claim 25 is allowable as well.

Applicant respectfully points out that the Office Action has not addressed the dependent claims. In general, the dependent claims set forth numerous elements not shown or suggested in the cited references. For example, claim 12, which depends from claim 1, features “the probe light is configured to receive power from the battery test circuitry.” Nothing in the

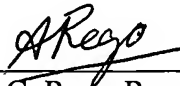
cited prior art teaches or suggests anything about a probe light receiving power from battery test circuitry.

In view of the foregoing, Applicant respectfully requests reconsideration and allowance of claims 1-27. Favorable action upon all claims is solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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